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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/719,224

Filing Date: November 21, 2003

Appellant(s): O'GRADY ET AL.

Mark A. Charles
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/19/09 appealing from the Office action
mailed 4/16/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 22 and 23 are now included in the 35 U.S.C 103(a) rejection below.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Claims 24-32 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. After further consideration and consultation, the Examiner withdraws this rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------|---------------|---------|
| 5902574 | Stoner et al. | 5-1999 |
| 5612382 | Fike | 3-1997 |
| 5679324 | Lisboa et al. | 10-1997 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoner et al. (US 5,902,574) in view of Fike (US 5,612,382) and Lisboa et al. (US 5,679,324).

Applicant claims:

1. (Currently amended) A topical cosmetic composition for providing noticeably healthy looking human skin comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition,

wherein the topical cosmetic composition is in the form of a shaving gel and further comprises a lathering agent, a foaming agent, and/or a self-foaming agent.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Stoner et al. teach shaving preparations for improved shaving comfort which inherently provides noticeably healthy looking skin on humans (title and abstract). Stoner et al. teach a shaving composition in the form of **a self-foaming shaving gel** comprising a volatile hydrocarbon self-foaming agent (Claims 1, 9 and 10). Stoner et al. teach isopentane isobutene in the composition (column 11, example 4). Isopentane isobutene can be **propellants**. Stoner et al. teach the addition of lower alkanolamine salts of fatty acids and lower alkanolamine salts of N-fatty acyl sarcosines where the fatty moiety has 10 to 20 carbon atoms which are foaming agents (column 4, lines 1-27 and claims 5-7, 12 and 13). The Examiner interprets this to mean **a lathering agent**. Stoner et al. teach the addition of additives such as **aloe** and vitamins such as **vitamin A** palmitate, **panthenol** and **vitamin E** as well as preservatives (Column 5, lines 33-53).

Stoner et al. teach **a second composition** to be used in the second part of the treatment (Column 7, lines 3-45). The second composition comprises a humectant in the form of an **aftershave splash, lotion or gel** (column 7, lines 40-42). Stoner et al. teach that the second composition can contain a wide variety of other cosmetic ingredients (column 7, lines 34-36).

Fike teaches the addition of 0.1 to 15 weight percent of **vitamin B₃** (niacin) or derivatives thereof to compositions for delivering active ingredients through the skin or mucosal tissues (Abstract; column 4, lines 46-67 and claims 1, 6 and 7, for example).

Lisboa et al. teach aerosol foamable fragrance compositions with respect to the shaving gel art (Abstract and column 1, lines 17-22). Lisboa et al. teach composition with from about 0.01 to about 10.0 % of α racemic **bisabolol** (claims 6 and 7).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. Stoner et al. does not expressly teach a topical cosmetic composition including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition.
2. Stoner et al. do not expressly teach a topical cosmetic composition with vitamin C, vitamin B₃ and bisabolol.
3. Stoner et al. do not expressly teach an array of topical cosmetic compositions for combined application to the skin comprising a second topical cosmetic composition selected from the group consisting of an aftershave gel, a moisturizing lotion, a cleansing wash and a cleansing bar wherein the second topical composition comprises vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B₃ and/or vitamin C or combinations of these ingredients.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make a topical cosmetic composition including vitamin

A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Stoner et al. teach the addition of vitamins and additives and provide guidance on the amount of additives to add in Column 11, example 4. Here, the only components greater than 5% by weight are water and the lathering agent and the additive dimethicone/dimethiconol is only present at 0.19 wt%. It is only a matter of judicious selection and routine optimization for one of ordinary skill in the art to add other additives, such as vitamins, in the amount taught by Stoner et al. to read on the amount instantly claimed.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add vitamin B₃ in an amount from 0.1 to 15 % by weight, as suggested by Fike, 0.01 to 10 wt% bisabolol, as suggested by Lisboa et al., and vitamin C to the composition of Stoner et al. and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because the references are directed to topical skin compositions and it is obvious to one of ordinary skill in the art to combine the combinations. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea

of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Stoner et al. teach the addition of vitamins and vitamin C is obvious to one of ordinary skill in the art.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make an array of topical cosmetic compositions for combined application to the skin comprising a second topical cosmetic composition selected from the group consisting of an aftershave gel, a moisturizing lotion, a cleansing wash and a cleansing bar wherein the second topical composition comprises vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B₃ and/or vitamin C or combinations of these ingredients and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Stoner et al. teach a method and compositions comprising more than one cosmetic composition as described above. It is merely a matter of judicious selection and routine optimization for one of ordinary skill in the art to produce a second composition comprising vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B₃ and/or vitamin C or various combinations of such ingredients which are taught in the art by Stoner et al, Lisboa et al., and Fike for the same use as described above.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of

ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

(10) Response to Argument

Appellant argues the references individually and Appellant asserts that the cited references have distinct purposes. Appellant asserts that there is no apparent reason flowing from the supplied references why a person of ordinary skill in the art of developing shaving gels would have combined the prior art elements in the manner claimed. Respectfully, the Examiner cannot agree. First of all, the cited references all pertain to compositions that are applied to the skin and therefore have a commonality. Secondly, the primary reference of Stoner et al. teaches and suggests adding additional ingredients to the shaving gel composition. For instance in column 3, lines 37-48 of Stoner et al. (Examiner added emphasis):

The vehicle containing the reducing agent may also include a wide variety of other optional components depending upon the form and characteristics of the vehicle which are desired. For example, it may include agents which are known to promote swelling of the hair and/or enhance penetration of the reducing agent such as, for example, urea, thiourea, guanidine, amino guanidine and biguanide. Such agents are typically present at concentrations ranging from about 0.1M to about 2.0M. The vehicle may also optionally include surfactants, fillers, gelling agents, thickeners, emollients, moisturizers, fragrances, coloring agents, and

And in column 5, lines 33-49 of Stoner et al. (Examiner added emphasis):

Other useful additives which may be utilized in the composition include humectants such as glycerin, sorbitol, and propylene glycol, emollients including fatty esters such as isopropyl myristate, decyl oleate, 2-ethylhexyl palmitate, PEG-7 glyceryl cocoate, and glyceryl linoleate, propoxylated fatty ethers such as PPG-10 cetyl ether and PPG-11 stearyl ether, di- and triglycerides such as lecithin and caprylic/capric triglyceride, vegetable oils, and similar materials, skin freshening and soothing agents such as menthol, aloe, allantoin, lanolin, collagen and hyaluronic acid, lubricants such as polyethylene oxide, fluorosurfactants, and silicones (e.g. dimethicone, dimethiconol, dimethicone copolyol, stearyl dimethicone, cetyl dimethicone copolyol, phenyl dimethicone, cyclomethicone, etc.), vitamins (including vitamin precursors and derivatives) such as panthenol, vitamin E, tocopherol acetate, and vitamin A palmitate, colorants, fragrances, antioxidants and preservatives. As mentioned

It is the Examiner's position that it is obvious for one of ordinary skill in the art to combine known ingredients for their known properties and produce an expected product. Appellant has not provided any unexpected results nor argued the combined reference rejection. It appears to the Examiner that Appellant has merely followed the road map provided by Stoner et al. to arrive at the instant combination of ingredients in the absence of evidence to the contrary. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." And; "The results of ordinary innovation are not the subject of exclusive rights under the patent laws." KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. pgs. 12, 24; 550 U. S. ____ (2007)".

In summary, the Examiner can only conclude that in the case presented here, the answer to the question as to “whether the improvement is more than the predictable use of prior art elements according to their established functions” is no. (MPEP 2141[R-6]). All the elements claimed are also known in the art and would be expected to function in the same way. Vitamin A functions as vitamin A and bisabolol functions as bisabolol. All Applicant has done is assemble known elements in the art into one composition. This is relevant to commercial success not invention. The fact that a combination has filled a long-felt want and has enjoyed commercial success will not, without invention, make the combination patentable. (See *ANDERSON'S-BLACK ROCK, INC., Petitioner, v. PAVEMENT SALVAGE CO.*, U.S.P.Q. 673, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258, 163). Appellant has not argued synergy or presented any unexpected results.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be

relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Ernst V Arnold/

Primary Examiner, Art Unit 1616

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Michael G. Wityshyn/
Acting Director, Technology Center 1600

Conferees:

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617

/Robert A. Wax/
Quality Assurance Specialist
Technology Center 1600